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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,637	12/12/2000	Greg Volgas	HCC-9 (306*141)	4754

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EXAMINER

LOVERING, RICHARD D

ART UNIT	PAPER NUMBER
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1712

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DATE MAILED: 06/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF=4

Office Action Summary

Application No. 09/734,637

Applicant(s) VOLGAS ET AL.

Examiner LOVERING

Group Art Unit 1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on MAR. 26 / APR. 23, 2001
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☐ Claim(s) 1-51 is/are pending in the application.
- Of the above claim(s) 1-28 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 29-51 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-51 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 243
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-28, drawn to homogeneous composition comprising fertilizer and deposition or drift agent, classified in Class 71, subclass 64.1.

II. Claims 29-51, drawn to homogeneous liquid composition consisting essentially of oil and deposition or drift reducing agent, classified in Class 516, subclass 31 or 53.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as solid fertilizer applied as powder or granules, not requiring an oil phase. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

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During a telephone conversation with Mr. Ashley I. Pezzner on May 23, 2002 a provisional election was made with traverse to prosecute the invention of Group II, claims 29-51. Affirmation of this election must be made by applicants in replying to this Office action. Claims 1-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 29-36, 38, 39, 40, 47-49 and 51 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated or at least anticipated by Arranaga 5,045,588, esp. Examples 2 and 4. As to claims 36, 39 and 49 herein, the organoclay derivative is a silicon based oil thickener, and the wetting agent is a surfactant.

5. Claims 37, 40 and 50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Arranaga above in view of Martin et al. 5,466,458.

The especially pertinent part of Arranaga is pointed out in the preceding paragraph. While Arranaga does not disclose a pesticide or insecticide, it would have been obvious to one skilled in the art at the time applicants' invention was made to incorporate the permethrin and S-bioallethrin or chlorpyrifos methyl of Examples 1A or 1, resp. of Martin et al. in the composition of Example 2 of Arranaga to impart a pesticidal or insecticidal property thereto. The use of a known additive for its known function lacks patentable significance. See In re Sussman 554 O.G. 17, 1943 C.D. 518.

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6. Claims 4~~1~~-44 and 51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dolan et al. 5,523,014.

Dolan et al. (Table VI) disclose a final formula containing inter alia odorless mineral spirits, white mineral oil, linear alcohol ethoxylate and hydroxypropyl guar. While Dolan et al. in this embodiment don't make the composition (i.e. final formula) by incorporating the hydroxypropyl guar in the oil phase, they clearly suggest doing this in the sentence bridging columns 7 and 8, and thus render it prima facie obvious.

7. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan et al. as applied to claims 4~~2~~-44 and 51 above, and further in view of Milberger et al. 2,828,261.

Dolan applies as in the preceding paragraph. While Dolan may not disclose the use of a silicon based oil thickener, it would have been obvious to one skilled in the art at the time applicants' invention was made to incorporate the silica aerogel (Santocel) of Milberger et al. into the oil phase of the final formula of Dolan et al. to impart the desirable properties of good temperature susceptibility and water resistance taught by Milberger et al. (column 1, lines 16-18).

8. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan et al. as applied to claims 4~~3~~¹-44 and 51 above, and further in view of Martin et al., above.

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Dolan et al. applies as in paragraph 6 above. While Dolan et al. do not disclose a pesticide or insecticide, it would have been obvious to one skilled in the art at the time applicants' invention was made to incorporate the permethrin and S-bioallethrin or chlorpyrifos methyl of Example 1A or 7, resp. of Martin et al. into the oil phase of the final formula of Dolan et al. above to impart a pesticidal or insecticidal property thereto. The use of a known additive for its known function lacks patentable significance. See the above-cited Sussman decision. Note that Dolan et al. contemplate the addition of preservatives (column 3, lines 33-35).

9. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 37, 40, 41, 43-46 and 50 are provisionally rejected under the judicially created doctrine of obviousness-

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type double patenting as being unpatentable over claims 1-6 of copending application Serial No. 09/765,765. Although the conflicting claims are not identical, they are not patentably distinct from each other because the stated instant claims at least overlap the claims of the '765 application.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 40-46 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

a) Claim 43 is indefinite in lacking antecedent basis in claim 40 for "said natural gum"; and b) claims 43-46 are substantial duplicates of claims 34, 35, 39 and 40, respectively. (It appears that claim 43 should depend upon claim 42.)

13. The remaining references listed on the attached Forms PTO-1449 (two sheets) and Form PTO-892 are cumulative to the references applied herein, and/or further show the state of the art.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
May 24, 2002

RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP 1200 1700